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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/574,068

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Alan Jay Cook

330802-00004

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27160

7590

08/19/2009

KATTEN MUCHIN ROSENMAN LLP

(C/O PATENT ADMINISTRATOR)

2900 K STREET NW, SUITE 200

WASHINGTON, DC 20007-5118

EXAMINER

BENEDIK, JUSTIN M

ART UNIT

PAPER NUMBER

3644

MAIL DATE

DELIVERY MODE

08/19/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/574,068

Applicant(s)

COOK ET AL.

Examiner

JUSTIN BENEDIK

Art Unit

3644

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-12 and 58-63 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 13-57 and 64-91 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-12 and 58-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date See Continuation Sheet
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :6/28/2006, 11/1/2007, 3/6/2008, 2/3/2009.

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-3, 13-56, and 64-91, drawn to a self cleaning litter box.

Group II, claim(s) 4-7, drawn to a rake assembly.

Group III, claim(s) 8-12 and 58-63, drawn to a litter cartridge.

Group IV, claim(s) 57, drawn to a method for treating waste.

The inventions listed as Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: Group I claims an automated litter box having features that the rest of the claims lack. Group II is drawn towards the rake assembly which is a subcombination of Group I lacking the structure of the litter box. Group III is drawn towards a litter cartridge which is a subcombination of Group I and again lacks the structure of claim I. Claim IV is a method claim that does not disclose the structure as claimed in any of the previous Groups.

2. During a telephone conversation with John Paniaguas on 8/13/2009 a provisional election was made without traverse to prosecute the invention of Group III, claims 8-12 and 58-63. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-7, 13-57 and 64-91 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

4. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. **Failure to do so may result**

in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8-12 and 58-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thaler et al. (US 6,378,461 B1) in view of Kerr (US 4,193,624).

Regarding claim 8, Thaler teaches a tray (Abstract) for receiving litter, having a waste area (68) and a waste cover (69) covering said waste area.

Thaler does not teach the tray to be **directly** connected to the waste area.

Kerr teaches a tray (20) having two compartments directly connected to each other (Figs 2 and 3) having a cover (36). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the connected tray of Kerr into the invention of Thaler in order to provide a single disposable tray for ease of use and to make it easier to discard.

Regarding claim 9, Thaler teaches the cover (69) to be rotatably mounted (Fig 3).

Regarding claim 10, Thaler teaches the tray to be disposable (Abstract), therefore meaning it could be discarded after one use.

Regarding claim 11, Thaler and Kerr teach all of the limitations of claim 8. Thaler further teaches a tray (Abstract) for receiving litter, having a separate waste compartment (68).

Thaler does not teach the tray to be **directly** connected to the waste compartment.

Kerr teaches a tray (20) having two compartments directly connected to each other (Figs 2 and 3). It would have been obvious to one of ordinary skill in the art, at the time of the invention, to incorporate the connected tray of Kerr into the invention of Thaler in order to provide a single disposable tray for ease of use and to make it easier to discard.

Regarding claim 12, Thaler and Kerr teach all of the limitations of claim 11.

They do not teach the tray to be made from paper. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tray out of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

Regarding claim 58, Thaler teaches litter to be used in said tray (Abstract).

Regarding claim 59, Thaler teaches a cover for the tray (548) providing privacy for the animal as well as storage.

Regarding claims 60 and 61, Thaler teaches the lid (69) to be rotatably installed using tabs and a pin (Column 6 lines 55-67 and Column 7 lines 1-4) which is easily removably installed by a user.

Regarding claims 62 and 63, Thaler and Kerr teach all of the limitations of claim 8.

They do not teach the tray to be made from plastic or cardboard. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the tray out of paper, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. In re Leshin, 125 USPQ 416. See also Ballas Liquidating Co. v. Allied industries of Kansas, Inc. (DC Kans) 205 USPQ 331.

Conclusion

The prior art made of record and not relied upon considered pertinent to applicant's disclosure is located in the attached PTO-892 form and related to other litter/waste receptacle boxes.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN BENEDIK whose telephone number is (571)270-7824. The examiner can normally be reached on Monday-Thursday 8:00am-12:00pm and 1:00pm-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mansen Michael can be reached on (571)272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. B./
Examiner, Art Unit 3644

/Michael R Mansen/
Supervisory Patent Examiner, Art Unit 3644